

### Remarks

The drawings, specification, and claims were amended in accordance with the amendments above. The amendments are being made to clarify the invention, and to focus the claims on those aspects of the invention which are a commercial priority to the Applicant. The amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved. Because the rejections in the Office Action were made final, this Amendment and Response is being filed contemporaneously with a Request for Continued Examination (RCE) and the appropriate fee.

In the Office Action dated 05/05/2006, claims 22-27, 29, and 37 were rejected under 35 USC §103(a) as being unpatentable over Cash (US 6,517,406), Kimbrough (US 5,926,388), and Wolf (US 6,655,056). Claims 28 and 30-31 were rejected under 35 USC §103(a) as being unpatentable over Cash, Kimbrough, Wolf, and Lerner (US 3,660,926). Claim 32 was rejected under 35 USC §103(a) as being unpatentable over Cash, Kimbrough, and Wolf. Claims 33-34 were rejected in view of Official Notice. Claims 35-36 were apparently rejected, though no art or statutory provision were cited against those claims. Claims 38-40 were rejected under 35 USC §103(a) as being unpatentable over Cash and Kimbrough. Claims 41-43 were rejected under 35 USC §103(a) as being unpatentable over Cash, Kimbrough, and Lerner. In view of the amendments made herein, Applicant respectfully traverses these rejections.

Under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching, suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01.

The combined art of record fails to teach each and every element recited in amended independent claim 22. For instance, and without limitation, the art of record fails to teach or

suggest a computer-generated three-dimensional representation of a ball associated with the sport from which the famous athlete is associated, as recited in amended claim 22. Amended claim 22 also includes a limitation that at least a portion of the three-dimensional representation of the face protrudes outwardly from the three-dimensional representation of the ball, which is neither taught nor suggested in the combined art of record. In short, the art of record, even in combination, fails to teach or suggest each and every element and limitation recited in amended independent claim 22 in accordance with MPEP 2143.03. Accordingly, the combined art of record fails to render obvious amended claim 22. In view of the foregoing, Applicant respectfully requests that the rejection be withdrawn.

Similarly, the combined art of record fails to teach each and every element recited in amended independent claim 38. For instance, and without limitation, the art of record fails to teach or suggest a computer-generated three-dimensional representation of an article of fame associated with the famous person, as recited in amended claim 38. Amended claim 38 also includes a limitation that at least a portion of the three-dimensional representation of the face of the famous person protrudes outwardly from the three-dimensional representation of the article of fame, which is neither taught nor suggested in the combined art of record. In short, the art of record, even in combination, fails to teach or suggest each and every element and limitation recited in amended independent claim 38 in accordance with MPEP 2143.03. Accordingly, the combined art of record fails to render obvious amended claim 38. In view of the foregoing, Applicant respectfully requests that the rejection be withdrawn.

The combined art of record also fails to teach each and every element recited in amended independent claim 41. For instance, and without limitation, the art of record fails to teach or suggest a computer-generated three-dimensional representation of an article of fame associated with the famous person as recited in amended claim 41. Amended claim 41 also includes a limitation that at least a portion of the three-dimensional representation of the face of the famous person protrudes outwardly from the three-dimensional representation of the article of fame associated with the famous person, which is neither taught nor suggested in the combined art of record. Furthermore, amended claim 41 includes limitation of a computer-generated three-dimensional representation of the body of the famous person, which is neither taught nor

suggested in the combined art of record. In short, the art of record, even in combination, fails to teach or suggest each and every element and limitation recited in amended independent claim 41 in accordance with MPEP 2143.03. Accordingly, the combined art of record fails to render obvious amended claim 41. In view of the foregoing, Applicant respectfully requests that the rejection be withdrawn.

Furthermore, even if the combined art of record taught or suggested all of the elements of any of the amended independent claims, the art is devoid of any suggestion or motivation to modify or combine the teachings of the references in order to obtain the claimed invention. Indeed, MPEP 2143.01 admonishes that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (emphasis in original). *Actual evidence* of a suggestion, teaching or motivation to combine prior art references must be shown. *In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999). Broad *conclusory statements* regarding the teaching of references, standing alone, simply *are not evidence*. *Id.* Rather than providing any actual evidence of a motivation to combine as required under the law, the Office has merely advanced subjective and unsubstantiated opinions of an individual Examiner rendered several years after the priority date of the present application. These opinions do not include citation of any portions of the prior art that purportedly provide a motivation to combine or modify the teachings of the references; nor are the subjective opinions articulated in terms of being what would have been in the mind of one of ordinary skill in the art at the time of the invention. Instead they appear to be nothing more than off-the-cuff reasons devised by the Office as to why some person at an arbitrary point in time might find the claimed combinations desirable. Applicant submits that this falls far short of the burden imposed on the Office by MPEP 2143.01. Furthermore, the Office’s position on motivation to combine is tantamount to an “obvious to try” rationale, which cannot be sustained under MPEP 2145.

In addition, the Office has appeared to attempt to satisfy its burden under MPEP 2143.01 by simply faulting the Applicant for not explicitly stating that claimed combinations provide particular advantages. (See, e.g., the third sentence of paragraph 5 on page 4 of the Office Action dated 05/05/06; the second sentence of paragraph 7 of the Office Action; the second

sentence of paragraph 8 on page 5 of the Office Action). This rationale is improper, as it amounts to impermissible burden-shifting by the Office. In other words, the burden is on the Office to establish obviousness in accordance with MPEP 2143, and the Applicant is under no burden to establish non-obviousness unless and until the Office has established a *prima facie* case of obviousness. The Office cannot purport to establish a *prima facie* case of obviousness merely by stating or suggesting that the Applicant has failed to disprove a *prima facie* case of obviousness. In short, the Office Action fails to provide the requisite *evidence* in the prior art suggesting the desirability of the combinations claimed herein, but instead relies solely on conclusory statements. Because the motivation required by MPEP 2143.01 is lacking, Applicant respectfully requests that the rejections be withdrawn.

While several distinctions have been noted over the art of record, Applicant notes that there are several other limitations recited in the present claims which are neither taught nor suggested by the art of record. Applicant expressly reserves all rights and arguments with respect to distinctions not explicitly noted herein. In addition, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant submits that all pending claims overcome the rejections presented in the Office Action, and respectfully requests reconsideration and an early notice of allowance. Should the Examiner wish to discuss the amendments or remarks made herein, the Applicant invites the Examiner to contact the undersigned via telephone at (513)369-4811 or via e-mail at [aulmer@fbtlaw.com](mailto:aulmer@fbtlaw.com).

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'A. B. Ulmer', written over a horizontal line.

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